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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,147	09/26/2001	Richard Davidson	2001P10389 US	1744

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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TAYLOR, BARRY W

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 06/22/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,147

Applicant(s)

DAVIDSON ET AL.

Examiner

Barry W Taylor

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 14 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example, newly added claims 14 and 15 recite "from only a public telephone number" and "from only public numbers". The Examiner is unable to find support in Applicant's specification.

2. Claims 17-18 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example, newly added claims 17-18 and 20 generally recite "on a per call basis". The Examiner is unable to find support in Applicant's specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robuck (5,991,367) in view of Hill et al (6,542,596 hereinafter Hill).

Regarding claims 1-5, 8-11. Robuck teaches rejecting unwanted telephone calls, such as those from telemarketers, while still allowing personal calls to ring through to the user, all without any user input (lines 1-5 of abstract). Robuck realizes that Caller ID works only on local calls, as some out-of-state (i.e. jurisdictions) do not send their telephone number to the caller id unit (col. 2 lines 1-7) rendering caller id useless because user still has to manually view the "block out" telephone number. Therefore, Robuck telephone call screener eliminates unwanted telephone calls, while still allowing

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desirable calls (col. 2 lines 10-14). Robuck discloses using an announcement to filter incoming calls. For example, if this call is from a telemarketer, salesperson, or solicitor, please hang up, and do not call here ever again. If this is from a family member or a personal friend, please press designated key (i.e. digit) and if correct key entered telephone allowed to ring, and if not, telemarketer disconnected (col. 5 lines 1-5). Robuck further discloses preventing the telephone to ring when any other digit is dialed, as would be a result of incoming telemarketer call (col. 5 lines 34-37) not responding correctly to the requested digit.

Robuck does not explicitly show determining if the number is private or public.

Hill also teaches privacy screening service that discriminates between two types of numbers (i.e. public and private). If the number is public the telephony is allowed to ring and if private the caller is requested to enter a designated digit "1" allowing for private number to be provided to called party or enter designated digit "2" to refuse private number being disclosed which causes disconnect to occur (col. 8 lines 10-18).

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of the invention to modify the teachings of Robuck by moving the call screening service to telephone company equipment as taught by Hill for the benefit of screening from telephone company equipment so that calling parties may enter override digit allowing for their private number to be known to the called party.

Regarding claim 6. Robuck teaches querying for digit to be used for screening callers. Hill also shows using "1" to indicate that identifier for caller is to be provided to calling party.

Regarding claims 7 and 19. Robuck does not show using busy signal from network. However, it is well known in the art of telephony to use busy signal to calling party when called phone is off-hook. Furthermore, Robuck discloses alternate embodiments where the call screener could be located in a business telephone system or at the telephone company (last three lines abstract, col. 4 lines 32-35).

Hill also teaches privacy screening service that discriminates between two types of numbers (i.e. public and private). If the number is public the telephony is allowed to ring and if private the caller is requested to enter a designated digit "1" allowing for private number to be provided to called party or enter designated digit "2" to refuse private number being disclosed which causes disconnect to occur (col. 8 lines 10-18).

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of the invention to modify the teachings of Robuck by moving the call screening service to telephone company equipment as taught by Hill for the benefit of screening from telephone company equipment so that calling parties may enter override digit allowing for their private number to be known to the called party.

Computer claim 12 is rejected for the same reasons as method claims 1-3 since the recited method would perform the claimed program steps.

Computer claim 13 is rejected for the same reasons as jurisdictions method claims 4-5 and 8-10 since the recited jurisdiction method claims would perform the claimed program steps.

Regarding claims 14-16. Robuck does not explicitly show determining if the number is private or public.

Hill also teaches privacy screening service that discriminates between two types of numbers (i.e. public and private). If the number is public the telephony is allowed to ring and if private the caller is requested to enter a designated digit "1" allowing for private number to be provided to called party or enter designated digit "2" to refuse private number being disclosed which causes disconnect to occur (col. 8 lines 10-18).

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of the invention to modify the teachings of Robuck by moving the call screening service to telephone company equipment as taught by Hill for the benefit of screening from telephone company equipment so that calling parties may enter override digit allowing for their private number to be known to the called party.

Regarding claims 17-18 and 20. Robuck does not show subscribers, subscribing to service on a per call basis.

Hill also teaches privacy screening service that discriminates between two types of numbers (i.e. public and private). If the number is public the telephony is allowed to ring and if private the caller is requested to enter a designated digit "1" allowing for private number to be provided to called party or enter designated digit "2" to refuse private number being disclosed which causes disconnect to occur (col. 8 lines 10-18).

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of the invention to modify the teachings of Robuck by moving the call screening service to telephone company equipment as taught by Hill for the benefit of screening

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from telephone company equipment so that calling parties may enter override digit allowing for their private number to be known to the called party.

### ***Response to Arguments***

4. Applicant's arguments filed 3/31/04 have been fully considered but they are not persuasive.

a) Regarding Applicant's remark on page 14 wherein Applicant's argue there is suggestion or motivation demonstrated.

The Examiner notes that both references directed at screening unwanted telephone calls. In other words, the motivation is self-evident. For example, Robuck is very clear that the screener could be implemented in a business telephone system or at a telephone company. Realizing this, and the fact that Hill uses database at telephone company to store subscriber information to "trigger" when subscriber condition occurs during telephone call through intelligent network would have been obvious for one of ordinary skill in the art at the time of invention to modify the screening service offered by Robuck to screen telephone calls at the telephone company equipment as taught by Hill so that subscribers subscribing to screening service will have telephone calls screened prior to ringing subscriber's telephone.

b) Applicants argue that Robuck fails to teach providing caller id to subscribers of such service (see bottom of page 14 and continuing to page 15).



The Examiner notes that the claim language of providing caller id to only subscribers is extremely well known in the art of caller id. Therefore, prior art already teaches charging for special services such as caller id and therefore is not novel subject matter. Furthermore, Hill discloses providing special services to subscribers (see at least first two lines of abstract and col. 3 lines 16-18).

c) Applicant's argue that Robuck fails to teach determining if the number is private or public (see page 15).

The Examiner agrees. That is why the Examiner used secondary reference of Hill (see rejection listed above).

d) Applicant's contend that Hill fails to determine whether the called party subscribes to caller-ID feature (see last eight lines on page 15).

The Examiner respectfully disagrees. Hill uses intelligent network wherein subscribers are offered screening service to be implemented at the telephone company equipment. In other words, Hill uses subscriber profile to cause "trigger" condition when calls to subscriber's number occur.

e) Applicant's continue to argue (see second paragraph on page 16) that Hill is a generally passive operation that always occurs at the final stage of a call (e.g. when ringing occurs).

The Examiner respectfully disagrees. If this where true, why would Hill even bother with using Terminating Attempt Trigger wherein database is first queried for subscriber profile information (see at least figure 4 wherein top shows call screening at

telephony equipment before routing (i.e. ringing) to subscriber's located at bottom of figure 4).

f) Applicant's next arguing that Robuck and Hill fail to consider jurisdiction to be used in call screening (see third paragraph on page 16).

The Examiner notes that Applicant's define jurisdiction as public or private telephone numbers and Hill alone teaches both private and public (abstract and figure 4). Furthermore, Hill uses subscriber profiles to determine how to handle calls to subscriber's that subscribe to privacy screening service.

g) Next (see last paragraph on page 16), Applicant's skip dependent claims 6 and 7 contending that dependent claims should be allowable without addressing Examiner's rejection listed above.

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W Taylor whose telephone number is (703) 305-4811. The examiner can normally be reached on Monday-Friday from 6:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 customer service Office whose telephone number is (703) 306-0377.

  
CURTIS KUNTZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600